

REMARKS

Claims 2, 3, 5, 15, 17-18, 25-26, 29-30, 33-34, 37 and 39-40 remain pending in the application.

Allowable Subject Matter

Applicants acknowledge with thanks the indication of allowable subject matter of claims 5, 17, 26, 34 and 40. In view of the following remarks, it is believed that all other pending claims should also be found to be allowable.

Withdrawal of Rejections and Objections

Applicants acknowledge with appreciation the withdrawal of the rejections based on the Leon et al and Van Damme et al references in view of applicants' prior response.

Applicants also presume that the objection to the claims as being substantially duplicates is also overcome, although this is not so stated in the Advisory Action. Confirmation of this withdrawal is requested.

Rejection under 35 USC 102(e) over Verschueren et al

Claims 2-3, 9-10, 15, 18, 20, 23, 25, 27, 29-33, 35, 37-39, and 41 stand rejected under 35 USC 102(e) as being anticipated by Verschueren et al.

In applicants' response of February 1, 2005, rejected claims 9, 10, 20, 23, 27, 31, 32, 35, 38 and 41 were cancelled. Claims 2, 3, 15, 18, 25, 29, 30, 33, 37 and 39 remain under rejection.

This rejection respectfully is traversed.

Verschueren et al is directed to a heat-sensitive material for making lithographic printing plates having on a lithographic support an image-forming layer including a hydrophilic binder, a crosslinking agent for the hydrophilic binder, *metal oxide particles with a mean diameter of at least 100 nm*, and dispersed hydrophobic thermoplastic polymer particles.

The reference teaches that particles of titanium dioxide or other metal oxide are incorporated in the heat-sensitive layer. Such particles are present in an amount of from 50 to 95% by weight based on the heat-sensitive layer, and preferably from 60 to 90% by weight. The Examiner's attention is directed to column 3, line 60 to column 4, line 4 of the reference in this regard.

The examples of the reference confirm that titanium oxide is present in amounts of at least 48% by weight (Example 1: 53.4%; Example 2: 48.3%; Example 3: 55.7%; Example 4: 54.5%; and Example 5: 52.1%). The particles are incorporated into the composition to "provide a uniform rough texture consisting of microscopic hills and valleys" (see paragraph bridging columns 3

and 4 of the reference). In order to achieve this result, the particles are present in significant amounts as discussed above.

By contrast, applicants' claimed photosensitive composition does not contain metal oxide particles as an essential component. Claims 2, 3 and 37 were previously amended to state that the recited photosensitive composition "consists essentially of" the recited components (which do not include metal oxide particles).

The Examiner in the Advisory Action of February 17, 2005 takes the view that applicants' claim amendments do not distinguish over the cited reference, stating "Applicant has not demonstrated how other components of the image forming layer taught by Verschueren et al, particularly the metal oxide particles, materially affect the basic and novel characteristics of the claimed invention." The Examiner relies on *In re Herz*, 190 USPQ 461 (CCPA 1976) as support for this position.

The Examiner's position is without basis. Applicants' claims are rejected as being anticipated by the reference. The reference clearly fails to suggest a composition which contains little, if any, metal oxide particles - the reference instead teaches that the composition should contain metal oxide particles in amounts of from 50-95% by weight. The reference thus clearly fails to disclose or anticipate applicants' claimed invention.

Indeed, it is noted that the Herz decision relied upon affirmed a rejection under 35 USC 103, not one under 35 USC 102. The Herz decision is accordingly believed inapplicable to the present fact situation where the Examiner rejects the claims under 35 USC 102.

The rejection is thus improper and should be withdrawn.

In view of the above, the application is believed to be in condition for allowance and an early indication of same is earnestly solicited.

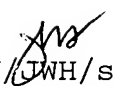
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Marc S. Weiner
Reg. No. 32,181
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000


MSW/JWH/sh
1155-0264P